

Application No.: 09/972124

Case No.: 56764US002

REMARKS

Claims 1-8 and 10-21 are pending. Claim 9 has been canceled. Claims 19 and 20 have been withdrawn from consideration. Claims 1, 7, 8 and 21 are amended.

§ 112 Rejections

Claims 1-8, 10-18 and 21 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention.

Examiner asserts that in each of the independent claims, the “adhesive layer” which ends the claim has no meaningful structural relationship with the remainder of the claim. Applicants have amended claims 1 and 21 to more clearly define the present invention. Support for these amendments can be found, for example, on page 2, lines 22-25; Figures 1 and 2; and claim 9. Applicants respectfully submit that the amendments clarify the Examiner’s rejections with respect to the various layered relationships that exist.

Examiner asserts that “with respect to claims 7 and 8, the newly added phrase ‘exposed to the air’ is unclear just as how the structural relations that can exist have been changed from what previously existed.” Applicants have amended claims 7 and 8 to more clearly define the present invention. These amendments are not intended to, and do not limit the original scope of the claims. Support for the amendments can be found, for example, in Figures 2 and 3 and the accompanying description at page 3, lines 12-13; and page 15, lines 4-19.

Applicants respectfully submit that claims 7 and 8, analyzed in light of the content of the application disclosure and the claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made, appraises one of ordinary skill in the art of its scope and therefore, serves the notice function required by 35 U.S.C. § 112, second paragraph. (MPEP § 2173.02)

In summary, Applicants submit that the rejection of claims 1-8, 10-18 and 21 under 35 U.S.C. § 112, second paragraph should be withdrawn.

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§ 103 Rejections

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. (See M.P.E.P. 706.02(j).)

Claims 1-18 and 21 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over JP -244, either taken individually, or for claims 7 and 8 in further view of EP -264. Additionally, Claims 1-18 and 21 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over JP -953, either taken individually or for claims 7 and 8 in further view of EP -264.

Neither Japanese reference teaches or suggests a first layer comprising a transparent film, the first layer having a first major surface and a second major surface opposite the first major surface; a second layer comprising a fluid transport substrate, the second layer having a first major surface and a second major surface opposite the first major surface, the first major surface of the second layer being in contact with the second major surface of the first layer; a third layer comprising a fluid transportable ink, the third layer having a first major surface and a second major surface, the first major surface being in contact with the second major surface of the second layer; and an adhesive layer in contact with the second major surface of the third layer.

Both JP -244 and JP -953 teach an ink layer located between the transparent layer and the fluid transport substrate. The Examiner asserts that the location of the ink layer is simply a matter of routine choice that is well within the ordinary skill of the art.

Applicants respectfully traverse. As both JP -244 and JP -953 teach a functional water-indicating device, there is no motivation to modify these devices as suggested by the Examiner. Furthermore, absent the teaching of the present application, there is nothing in the cited references which provides a reasonable expectation for success should the proposed

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modifications to JP -244 or JP -953 be made. Neither JP -244 nor JP -953 teaches or suggests that, if the ink layer were placed on the side of the fluid transport substrate opposite the transparent layer, that the change in the ink which occurs upon contact with water would be visible when viewed through the transparent layer.

EP -264 fails to address this deficiency in JP -244 and JP -953.

With regard to claims 7 and 8, EP -264 fails to teach or suggest a hole through a first layer comprising a transparent layer, exposing a second layer comprising a fluid transport substrate (see, amended claim 7). Nor does EP -264 teach or suggest a hole through a first layer comprising a transparent layer, and a second layer comprising a fluid transport substrate, exposing a third layer comprising a fluid transportable ink layer (see, amended claim 8.)

Referring to Figure 1, EP -264 teaches a lower case 2 provided with a hole 3 bonded to a transparent sheet 5. The hole permits the plain paper and ink to be visible through the transparent layer, but the transparent sheet blocks the white plain paper and the ink layer from exposure to fluids passing through the hole in the case. (See, col. 2, lines 34-51.)

For at least these reasons, a prima facie case of obviousness has not been made with respect to Claims 1-18 and 21. The rejection of claims 1-18 and 21 under 35 U.S.C. § 103(a) as being unpatentable over JP -244 and for claims 7 and 8 in further view of EP -264 should be withdrawn. Additionally, the rejection of claims 1-18 and 21 under 35 U.S.C. § 103(a) as being unpatentable over JP -953 or for claims 7 and 8 in further view of EP -264 should be withdrawn.

In view of the above, it is submitted that the application is in condition for allowance. Reconsideration of the application is requested.

Allowance of claims 1-8, 10-18 and 21, as amended, at an early date is solicited.

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Date

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Version with markings to show amendments made:

1. (Twice Amended) An adhesive article comprising
a first layer comprising a transparent film, the first layer having a first major surface and a second major surface opposite the first major surface;
a second layer comprising a fluid transport substrate, the second layer having a first major surface and a second major surface opposite the first major surface, the first major surface of the second layer being in contact with the second major surface of the first layer;
a third layer comprising a fluid transportable ink, the third layer having a first major surface and a second major surface, the first major surface being in contact with the second major surface of the second layer; and
an adhesive layer in contact with the second major surface of the third layer.

7. (Twice Amended) The adhesive article of claim 1 having a hole through the first layer, exposing the second layer [wherein the first layer defines a hole, and the second layer is thereby exposed to the air].

8. (Twice Amended) The adhesive article of claim 1 having a hole through the first and second layers, exposing the third layer [wherein the first layer and the second layer define a hole, and the third layer is thereby exposed to the air].

21. (Twice Amended) A label comprising
a first layer comprising a transparent film, the first layer having a first major surface and a second major surface opposite the first major surface;
a second layer comprising a fluid transport substrate, the second layer having a first major surface and a second major surface opposite the first major surface, the first major surface of the second layer being in contact with the second major surface of the first layer;

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a third layer comprising a fluid transportable ink, the third layer having a first major surface and a second major surface, the first major surface being in contact with the second major surface of the second layer;

an adhesive layer in contact with the second major surface of the third layer; and
a printed layer on the first major surface of the first layer.